

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

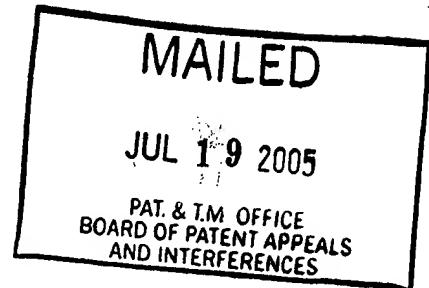
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL FANEUF

Appeal No. 2005-1272
Application 09/723,868

ON BRIEF



Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4, 5, 7, 8, 10 through 13, 15 through 17 and 19 through 22, all of the claims remaining in the application. Claims 3, 6, 9, 14, 18 and 23 through 25 have been canceled.

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Appellant's invention relates to an apparatus for use in sport fishing and, more specifically, to an apparatus for holding a fish without puncturing a hole in the fish and in a manner so as to make it easier for the user to retrieve the fish from a live well without having to reach below the surface of the water. Independent claims 1, 12 and 21 are representative of the subject matter on appeal, and a copy of those claims can be found in Appendix A of appellant's brief.

The prior art of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. 103 includes:

Johnson 6,044,582 Apr. 4, 2000

Applicant's admitted prior art as disclosed in
Figure 1 of the application (APA)

Claims 1, 2, 4, 5, 7, 8, 10 through 13, 15 through 17 and 19 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of APA.¹

¹ The rejection of claim 2 under 35 U.S.C. § 112, second paragraph, set forth on page 3 of the final rejection was overcome by an amendment filed January 2, 2004.

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Rather than reiterate the examiner's statement of the above-noted rejection and the conflicting viewpoints advanced by appellant and the examiner regarding the rejection, we refer to the final rejection (mailed October 10, 2003) and the examiner's answer (mailed May 12, 2004) for the reasoning in support of the rejection, and to the brief (filed April 1, 2004) and reply brief (filed July 12, 2004) for appellant's arguments to the contrary.

OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have made the determination that the evidence relied upon by the examiner is not sufficient to support a conclusion of obviousness under 35 U.S.C. § 103 with respect to appellant's claims 1, 2, 4, 5, 7, 8, 10 through 13, 15 through 17 and 19 through 22 on appeal. Our reasoning for this determination follows.

Like the examiner, we note that Johnson discloses a floating rope marker assembly and apparatus for holding a fish, comprising a length of rope (12) having a loop (27) formed at a first end for securing the rope to a clip (32). As noted in column 2, lines 32-34, the clip is a metal or plastic safety pin type hook assembly commonly found on fish stringers. The clip includes a base part (34) held within the looped end portion of the rope and a hook part (36) for releasably holding the fish. The second end of the rope includes a float (25) formed of closed cell polyfoam inserted into a hollow portion of the braided rope to keep that end of the rope afloat at the surface of the water in a live well.

Appellant's admitted prior art seen in Figures 1 and 2 of the application (hereinafter, APA) is a molded plastic clip (100) adapted to be secured to a plastic hanger (150) in the manner seen in Figure 2 of the application and used to secure an item (134), such as a pair of pants, to the hanger. The garment clip of APA is essentially structurally identical to the clip (100') used in appellant's fish holding apparatus.

In formulating the rejection of the claims before us on appeal the examiner contends that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention "to use the clipping device as taught by Admission [APA] as the clip disclosed by Johnson since the clipping device as taught by Admission [APA] includes a base part capable of being held within the lower end portion of a rope (area located beneath Biasing Member 116) and having a hook part adapted for releasably holding an item (i.e., a fish) as required by Johnson" (final rejection, page 4).

Like appellant, it is our view that the examiner's proposed modification of the floating rope marker assembly and fish holding apparatus of Johnson in view of the garment clip of APA is based upon impermissible hindsight derived from first having read appellant's disclosure and claims. In that regard, we note, as our court of review indicated in In re Fritch, 972 Fd. 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Simply stated, we find no reasonable basis in the collective teachings of the applied prior art which would have provided any suggestion or motivation for the particular combination proposed by the examiner. As has been pointed out by appellant in the reply brief, a central feature of the claimed invention lies in the strategic placement of the loop of rope on the clip (100') such that it exerts a force on the biasing member (116') which increases the gripping force between the first and second protrusions (136', 138') when a weight is hanging from the clip. Absent appellant's disclosure, the examiner has shown no basis in the applied prior art for using the garment clip of APA in such a manner, even if it were to somehow be combined with the floating rope marker assembly and fish holding apparatus of Johnson.

Since we have determined that the teachings and suggestions found in Johnson and APA would not have made the subject matter as a whole of independent claims 1, 12 and 21 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103. It follows that the examiner's rejection of dependent claims 2, 4, 5, 7, 8, 10, 11, 13, 15 through 17, 19, 20 and 22 under 35 U.S.C. § 103(a) based on the teachings of Johnson and APA will likewise not be sustained.

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The examiner's citation and reliance upon Yaman (JP 0369846) and "Plasti-Clip HANG UPS" in the final rejection (page 5) and answer (pages 3-4) does nothing to change our view as expressed above.

In light of the foregoing, the decision of the examiner rejecting claims 1, 2, 4, 5, 7, 8, 10 through 13, 15 through 17 and 19 through 22 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT)
Administrative Patent Judge)
John P. McQuade)
JOHN P. McQUADE)
Administrative Patent Judge)
Jeffrey V. Nase)
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